

**REMARKS**

Claims 1-20 are pending, of which claims 7-17 are withdrawn from consideration. Accordingly, claims 1-6 and 18-20 have been examined in the current Office Action.

The Examiner has repeated the rejection of claims 3 and 6 under 35 U.S.C. § 103(a) in view of Roder and Adams, as well as the rejection of claims 19 and 20 under 35 U.S.C. § 103(a) in view of Roder. Further, claims 1, 2, 4, 5, 18 and 19 have been rejected under 35 U.S.C. § 102(b) in view of U.S. Patent No. 4,874,139 to Kewin, claims 1, 2, 4, 5 and 18 have been rejected under 35 U.S.C. § 103(a) in view of Roder, claim 20 has been rejected under 35 U.S.C. § 103(a) in view of Kewin, and claims 3 and 6 have been rejected under 35 U.S.C. § 103(a) in view of Kewin and Adams.

**Preliminary Matter**

On May 26, 2004, the undersigned contacted the Examiner to informally discuss the enclosed claim amendments. Since the Examiner indicated that the enclosed claim amendments would require further search and consideration, Applicant is filing herewith a Request for Continued Examination (RCE), in order to have the claim amendments entered.

**Rejections under 35 U.S.C. § 102(b)**

Claims 1, 2, 4, 5, 18 and 19 have been rejected under 35 U.S.C. § 102(b) as being anticipated by Kewin.

**A. Claim 1**

Applicant submits that claim 1 is patentable over the cited reference. For example, claim 1 recites that a target is configured to provide information to identify a type of a sheet roll. The “type” of sheet roll comprises at least one of a material of the sheet roll, a thickness of the material, a width of the material, a quantity of winding of the material, and a sensitivity of the material.

The Examiner maintains that Kewin discloses the above features. However, the reference is not directed towards a determination of a “type” of the material, based on a target, as recited in claim 1. Rather, Kewin relates to providing a core member 12 having improved beam strength to reduce bending and distortion, and also to reduce flutter of paper supply at different rotational speeds (col. 4, lines 52-61).

The Examiner maintains that plug 26 of Kewin discloses the claimed target, alleging that the plug 26 “inherently” provides information to identify a type of sheet roll (Fig. 1 of Kewin; pg. 5 of Office Action). For example, the Examiner maintains that if the collar 14, of which the plug 26 is inserted, does not have the correct configuration, the plug 26 would not fit. The Examiner alleges that whether or not the plug 26 fits, inherently provides information to identify the “type” of sheet roll. However, contrary to the Examiner’s assertions, the plug 26 does not identify a “type” of sheet roll, as recited in claim 1. Rather, plug 26 appears to be used merely for gripping the core members 12 during shipping and storing (col. 4, lines 48-51; col. 5, lines 11-14). During use, it appears that the plug 26 is removed so that stub-shaft chucks of a printing

press can be inserted into the collar 14 to hold the core member 12 (col. 1, lines 42-47; col. 4, lines 2-4 and 31-37).

Regarding the Examiner's statements of inherency, the reference fails to disclose that different sizes of collars 14 and plugs 26 are manufactured, such that the different sizes indicate a different "type" of material. Rather, the reference merely discloses that the plugs 26 are shaped so as to form a "close fit" in the collars 14 (Fig. 5; col. 4, lines 40-43). Applicant notes that evidence of inherency in a reference "must make it clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill." Continental Can Co. USA Inc. v. Monsanto Co., 948 F.2d 1264, 1269 (Fed. Cir. 1991) (emphasis added). "Inherency, however may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." Id. (citing In re Oelrich, 666 F.2d 578, 581 (fed. Cir. 1981) (quoting Hansgirk v. Kemmer, 102 F.2d 212, 214 (C.C.P.A. 1939))) (emphasis in original); see also Scaltech Inc. v. Retec/Tetra L.L.C., 51 U.S.P.Q.2d 1055, 1059 (Fed. Cir. 1999); and In re Robertson, 49 U.S.P.Q.2d 1949, 1950-51 (Fed. Cir. 1999).

Accordingly, since Kewin fails to teach or even suggest that the collar 14 and plug 26 are sized or shaped due to the "type" of material on the core member 12, but rather, the construction of the collar 14 is intended to improve the strength of the core member 12, Applicant submits that the identification of a "type" of material is not "necessarily present" in the Kewin reference. Thus, it appears the Examiner has made an assumption regarding the function of the plug 26 and collar 14 which is not supported in view of the Kewin disclosure.

Based on the foregoing, Applicant submits that claim 1 is patentable over the Kewin reference, and respectfully requests the Examiner to reconsider and withdraw the rejection.

**B. Claims 2, 4, 5**

Since claims 2, 4 and 5 are dependent upon claim 1, Applicant submits that such claims are patentable at least by virtue of their dependency.

**C. Claim 18**

Applicant has canceled claim 18, without prejudice or disclaimer. Therefore, Applicant submits that the rejection of such claim is now moot.

**D. Claim 19**

Since claim 19 contains features that are analogous to the features recited in claim 1, Applicant submits that claim 19 is patentable over the cited reference for at least analogous reasons as presented above.

**Rejections under 35 U.S.C. § 103(a)**

1. Claims 1, 2, 4, 5 and 18-20 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,334,587 to Roder (“Roder”)

**A. Claim 1**

Applicant submits that claim 1 is patentable over the cited reference. For example, claim 1 recites that a target is not provided with electrical components. As stated in a non-limiting embodiment, the present invention allows a large number of types of sheet rolls to be discriminated with a simple structure (pg. 7 of Application).

The Examiner maintains that the holder 7 and code carrier 12 of Roder disclose the claimed target (Fig. 2). However, as stated in Roder, the code carrier 12 is essentially a “data memory device”, and respectively consists of “an electronic component with a memory and logical control device” (col. 3, lines 9-12). The code carriers are connected to recording heads for transmitting and receiving data, such as destination of the web roll (to which the code carrier is attached) (col. 2, lines 60-67 and col. 3, lines 1-8). Further, the data on the code carrier 12 can be erased, or new data can be added (col. 3, lines 39-42). Accordingly, since Roder discloses that the holder 7 is provided with an electrical component, which is contrary to the recitations of claim 1, Applicant submits that claim 1 is patentable over the cited reference.

In addition, Applicant submits that the features of claim 1 would not have been obvious in view of Roder. For example, even when obviousness is based on a single prior art reference, there must be a showing of a suggestion or motivation to modify the teachings of that reference. *In re Kotzab*, 55 USPQ2d at 1316-1317; *see also* MPEP § 2142 (*quoting Ex parte Clapp*, 227 USPQ 972, 973 (B. Pat. App. & Inter. 1985)) (“To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to

why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.”).

Applicant submits that there is no suggestion or motivation to modify Roder, such that the holder 7 no longer contains the code carrier 12. Rather, the entire Roder reference is based on the ability to add and erase data onto the small data memory (e.g., col. 1, lines 50-58). If the code carrier/data memory were removed from the holder 7, the invention of Roder would not work for its intended purpose. In addition, based on the teachings of Roder, one skilled in the art would be motivated to provide a web roll with an electrical component for memory capabilities, rather than a web roll without the electrical component, as recited in claim 1. Thus, Applicant submits that Roder teaches away from the recitations of claim 1.

Based on the foregoing, Applicant submits that claim 1 is patentable over the cited reference, and respectfully requests the Examiner to reconsider and withdraw the rejection.

#### **B. Claims 2, 4 and 20**

Sine claims 2, 4 and 20 are dependent upon claim 1, Applicant submits that such claims are patentable at least by virtue of their dependency.

#### **C. Claim 5**

Claim 5 recites that the type of the sheet roll is discriminated by determining in which of a plurality of predetermined positions the target is located. The Examiner continues to maintain

that the recitation is an “intended use” of the target, and therefore receives little patentable weight. However, for similar reasons as set forth in the February 6, 2004 Amendment, Applicant submits that the feature of determining a type of sheet roll based on a predetermined position of a target is a functional limitation that describes the function of the plurality of predetermined positions, and therefore, must be given patentable weight.

As set forth in MPEP §2173.05(g), there is nothing inherently wrong with defining some part of an invention in functional terms. “A functional limitation must be evaluated and considered, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used.” See MPEP §2173.05(g) (Emphasis added).

The Examiner maintains that one of ordinary skill in the art would have recognized that the target, i.e. code carrier 12, is placed in certain locations within the core tube to provide the user with sight confirmation of the particularities of the paper web material (pgs. 7 and 8 of the Office Action). However, contrary to the assertions of the Office Action, information on the code carriers 12 is read by the electronic recording/reading heads 27-29, where the code carriers 12 are data memory devices (col. 3, lines 1-15). Accordingly, such disclosure does not teach or suggest that the alleged particularities of the paper are determined via “sight confirmation.” In addition, Roder fails to suggest that a particular position of the code carriers 12 determines a “type” of sheet roll. Rather, it is the particular data encoded on the code carriers 12 that determines information such as the physical location of the web roll.

In view of the above, Applicant again submits that the recitations of claim 5 should be given patentable weight, and further, that Roder fails to teach or suggest the claimed features.

**D. Claim 18**

Since claim 18 has been canceled, without prejudice or disclaimer, Applicant submits that the rejection of such claim is now moot.

**E. Claim 19**

Since claim 19 contains features that are analogous to the features recited in claim 1, Applicant submits that such claim is patentable at least by virtue of its dependency.

2. Claims 3 and 6 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Roder in view of U.S. Patent No. 4,852,823 to Adams et al. (“Adams”).

Since claims 3 and 6 are dependent upon claim 1, and Adams fails to cure the deficient teachings of Roder, Applicant submits that such claims are patentable at least by virtue of their dependency.

3. Claim 20 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Kewin. However, since claim 20 is dependent upon claim 1, Applicant submits that claim 20 is patentable over the cited reference at least by virtue of its dependency.



4. Claims 3 and 6 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Kewin in view of Adams. However, since claims 3 and 6 are dependent upon claim 1, and Adams fails to cure the deficient teachings of Kewin, as set forth above, Applicant submits that claims 3 and 6 are patentable at least by virtue of their dependency.

**Conclusion**

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

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